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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,392	07/19/2000	Andrey A. Boukharov	04983.0130.NPUS01/38-21(5	2901

22930 7590 06/21/2002

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EXAMINER

ZHOU, SHUBO

ART UNIT PAPER NUMBER

1631

DATE MAILED: 06/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/620,392

Applicant(s)

BOUKHAROV ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 June 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4, 6-9 and 16-20.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE:

The amendment to claim 1 to read on "the nucleic acid sequence of SEQ ID NO:1 or the complements thereof", the amendment to claim 17 to read on "a nucleic acid molecule having the sequence of SEQ ID NO:1", and the amendment to claim 18 to read on "a nucleic acid molecule having the sequence of SEQ ID NO:1" will require new consideration and/or search.

Continuation of 5. NOTE:

In regard to the rejection of claims 1-4, 6-9, and 16-20 under 35 USC 101, applicants' argument is essentially the same as that provided in the previous response filed on 12/21/01. Applicants argue that probing for a particular gene is a specific utility and detecting the presence or absence of polymorphism is a specific and substantial utility. This is not deemed persuasive because, as set forth in the previous Office actions, probing for a gene is not specific to the claimed invention and detecting for the presence of polymorphism is not a substantial utility in this case because further research is needed to determine a specific, substantial and credible utility for the possible polymorphisms detected, e.g. its association with certain human conditions. Thus the rejection stands. For the same reasons, the rejection of the claims under 35 USC 112, first paragraph (enablement) is maintained.

In regard to the rejection of claim 1-4, 6-9, and 16-20 under 35 USC 112, first paragraph (written description), applicants' argument is essentially the same as that provided in the response filed 12/21/01. The argument is not persuasive because, as set forth multiple times in the previous Office actions, the species within the scope of the claimed genus, due to the use of "comprising" and/or "having", are highly variable. In view of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that the applicant was in possession of the genus as claimed. The rejection stands.

In regard to the rejection of claim 1-4, 6-9, and 16-20 under 35 USC 112, first paragraph (enablement-scope rejection), applicants argue that the finality of the March 2002 Office action is premature because the examiner admits "the specification is enabling for nucleotides of elected SEQ ID NO:1" in the Office action of Sept 2001, and then asserts in the March 2002 Office action that "there is a lack of enablement within the scope of elected SEQ ID NO:1". This is not deemed persuasive because applicants' allegation is incorrect. Nowhere in the Office action of March 2002 can one find that the examiner asserts "there is a lack of enablement within the scope of elected SEQ ID NO:1". What is asserted is that the specification "does not enable nucleic acids comprising or having the elected SEQ ID NO:1 for reasons set forth above". And the reasons set forth above was that the claimed invention, i.e. nucleic acids comprising or having the sequence of the elected SEQ ID NO:1 is a genus that contains highly variable species. Thus, the finality of the Office action of March 2002 stands.



MICHAEL BORIN, PH.D.
PRIMARY EXAMINER

